

## REMARKS

Claims 1, 3 and 4 have been rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. Claims 2 and 5 have been rejected as being anticipated under 35 U.S.C. 103(a) by *Sutton* (U.S. Pat. No. 5,968,118) in further view of *Klein* (U.S. Pat. No. 6,637,030). Applicant respectfully traverses these rejections and/or deems them overcome for at least the following reasons. Reconsideration of this application is thus respectfully requested.

### Rejection based on 35 U.S.C. § 112, first paragraph

Claims 1, 3 and 4 have been rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. Applicant respectfully traverses this rejection for at least the following reasons.

Rejections based on the first paragraph of 35 U.S.C. 112 for failing to comply with the written description requirement are appropriate when there is a difference in the definition of the claimed subject matter and the subject matter described in the specification. *In re Higbee*, 527 F.2d 1405 (CCPA 1976). Further, this rejection is appropriate when the claimed subject matter was not described in the specification in such a way as to reasonably convey the invention to one skilled in the art. *MPEP* § 706.03(c).

The present Office Action sets forth that “the specification discloses ‘the signals incoming from each of the addressable devices 202 are combined by a digital combiner 410, and passed through a traffic sensor 412 ...’”. *Office Action @ 3.*

Applicant has Amended Claims 1, 3 and 4 to remove the splitter language and include language directed to the combiner. Applicant submits that by so doing the rejection under 35 U.S.C. § 112 is traversed.

Wherefore, Applicant respectfully submits the requirements of § 112 having been met by Amended Claims 1, 3 and 4, and thus this rejection is overcome. Accordingly, Applicant respectfully requests reconsideration and removal of at least this rejection to Claims 1, 3 and 4.

Rejection based on 35 U.S.C. § 103 (a)

Claims 2 and 5 have been rejected as being anticipated under 35 U.S.C. 103(a) by *Sutton* (U.S. Pat. No. 5,968,118) in further view of *Klein* (U.S. Pat. No. 6,637,030). Applicant respectfully traverses this rejection for at least the following reasons.

35 U.S.C. §103(a) recites:

[a] patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability

shall not be negated by the manner in which the invention was made.

To establish a prima facie case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the references or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art and not based on applicant's disclosure. In re Vaeck, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). *MPEP 706.02(j)*.

Applicant respectfully submits that there is no motivation or teaching to combine the teachings of Sutton and Klein. Further, the combination of the teaching of Sutton and Klein does not render the present invention obvious.

The Examiner correctly recites that the Sutton reference is "silent as to the operation of the modulators and demodulators within the disclosed information outlet." *Office Action at 6*. Applicant respectfully submits that Sutton is designed to accomplish wiring for data communication without modification of the signals. Sutton places the signals for transmission unmodified directly onto the pre-run cables. *See Sutton generally*. The only modification of the signals contemplated or enabled in Sutton is compression, such as by MPEG. *Sutton, Col. 3*. The system of Sutton was designed to free bandwidth, which could arguably allow for modulation onto RF signals but the goals

of Sutton are in no way accomplished by, nor does Sutton contemplate or enable, modulating and demodulating. The present office action contends that there is a passing reference to modulators and demodulator within Sutton, but Applicant has found no clear teaching of how such modulation and demodulation occurs.

The present action states that the modulating and demodulating of Klein may be used to “fill the gap” in the teaching of Sutton as to what modulation and demodulation could be used. Applicant respectfully and strongly disagrees, as it is not clear, nor do Klein and Sutton teach in any manner, or even remotely suggest, that the technologies taught in either reference could be used when combined. This is because, simply put, to accomplish what is claimed in the present invention, Sutton and Klein cannot be combined.

As may be found in the teaching of Klein:

However, the use of this CATV wiring to support a local area network has not been previously accomplished as is described in detail in U.S. Pat. No. 5,255,267 to Hansen et al., it is possible to inject broadband video channels onto LAN cabling carrying thin Ethernet baseband communications. However, this requires that baseband signal energy at frequencies up to 25 MHz be blocked from entering the broadband video feed by a high pass filter. This filtering eliminates the possibility of sending upstream messages from the home to the cable service provider at, for instance, the 5 to 11 MHz upstream channel currently supported by cable television service providers. Furthermore, typical baseband transceivers are designed to operate with twisted pair cable or 50 ohm coaxial lines, not the 75 ohm coaxial cable pre-installed in homes and used for cable television delivery.

Col. 2, lines 5-21. Applicant respectfully points out that this is, in fact, the teaching of Sutton. Sutton and Klein teach diametrically different ways of expanding bandwidth in order to carry signals to a destination. Sutton is, in fact, designed to “cram” signals onto existing wiring, but does not teach how to accomplish this. In fact, as the present office action points out, “Sutton reference is silent as to how such modulation and demodulation occurs.” *Office Action @ 4*. If, in fact, the modulation was to occur as is taught in Klein, Sutton would be inoperable, as Sutton in fact teaches away from Klein.

For example, the wiring of Sutton is to be placed in a wiring closet, while wiring from the wiring closet to each device. The point of Klein is modulating in two different baseband frequencies, the first of which is from 5-42 MHz and the second from 50-750 MHz. Klein uses these two distinct bandwidths to prevent interference between upstream and downstream transmissions. Sutton must use a high pass filter to block certain established frequencies. Thus, Klein would not operate in Sutton, as one entire band of Klein would be blocked by Sutton’s filter, and therefore Klein would be non-operational with Sutton. Sutton in fact must leave the baseband portion in tact and in fact then operates as described in the cited portion of Klein hereinabove.

As Applicant has taught, the invention of the present application is not just the modulation of signals on a communication medium; it is, in fact, the modulation/demodulation of signals matched to the communication medium in order to maximize data flow. Applicants submit that this matching of modulation to the communication medium is clearly embodied within the claims. If the Examiner believes that such matching is not clearly set forth in the claims, Applicant would be happy to discuss a claim modification, but the Examiner has set forth, to date, a wholly incorrect

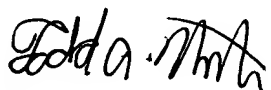
combination, and not an explanation of the perceived lack of clarity. As Klein does not match the modulating/demodulating to the medium, and more particularly to the medium of Sutton, and since Klein in fact does not teach any relevance to the matching of medium and modulation, the combination of Sutton and Klein does not teach Applicant's invention.

The present office action merely attempts to combine two methods of bandwidth control, but there exists no motivation, suggestion, or teaching to make such a combination nor does the combination, even if improperly made, teach the limitations of the instant claims. In fact, the combination of the teachings of Klein and Sutton teach away from combination, as each intends to accomplish the same goal in different ways. In other words, Sutton accomplishes bandwidth reduction using a series of steps, and one skilled in the art would not be motivated to add unnecessary steps from Klein to obtain the same result that would be obtained by Sutton alone. Such a combination would thus be inefficient and hence undesirable. As such, Applicant submits there is no motivation to combine Sutton and Klein.

## CONCLUSION

In summation, Applicant respectfully submits that all of the claims presently appearing in this application are in condition for allowance, early notification of which is earnestly solicited. Should there be any questions or other matters whose resolution may be advanced by a telephone call, the Examiner is cordially invited to contact Applicant's undersigned attorney at his number listed below.

Respectfully submitted,



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